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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,756	02/25/2002	Adolf Proidl	AT 010010	8274

24737 7590 12/28/2006
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

NGUYEN-BA, HOANG-VU A

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/084,756

Applicant(s)

PROIDL, ADOLF

Examiner

Hoang-Vu A. Nguyen-Ba

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/25/02, 6/19/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed February 25, 2002.
2. Claims 1-13 have been examined.

Priority

3. The priority date considered for this application is February 27, 2002, which is the filing date of the Application No. EP -1 890 053.0. A certified copy of the priority application has been received and placed in the application file.

Oath/Declaration

4. The Office acknowledges receipt of a properly signed oath/declaration filed February 25, 2002.

Information Disclosure Statement

5. The Office acknowledges receipt of the Information Disclosure Statements filed on February 25 and June 19, 2002. They have been placed in the application file and the information referred to therein has been considered.

Drawings

6. The drawing filed February 25, 2002 is accepted by the examiner.

Specification

7. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.

(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC. (See 37 CFR 1.52(e)(5) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX". (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING. (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc.).

Since Applicant's arrangement of the specification does not specifically show a Background of the Invention section, the portion of Applicant's Specification from p.1, line 6 to p. 2, line 13 is interpreted to be equivalent to the Office's suggested Background of the Invention and the information described therein is thus considered to be and used as admitted prior art.

8. The specification is objected to because of the following minor informalities:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objection

9. Claims 1-13 are objected to because of the following minor informalities:

Claims 1-13

Since the numerals and abbreviations associated with the limitations recited in these claims are not used thereafter to refer to the limitations in lieu

of the recitation of the entire limitation, they should be deleted to maintain consistency in the recitation of the limitations (e.g., at line 2 of claim 1, the numerals 1 and 2 refer to a recording device while the same numerals refer to playback devices at line 19) and improve readability of the claims.

Claims 1, 10 and 12

Claims 1 (line 11), 10 (line 11) and 12 (line 4) recite the adverb “[sic]”. This adverb should be deleted.

Claim Rejections – 35 USC §112

10. The following is a quotation of the second paragraph of the 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 2, 8, 10 and 11 are rejected under 35 U.S.C. §112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Lack of Proper Antecedent Basis

i. the limitation “the played back link information item” recited in Claim 1 at lines 12 and 16 appears to lack proper antecedent basis; this limitation should be changed to – the link information item – in order to have proper antecedent basis.

ii. the limitation “the recording carrier” recited in Claim 10 at lines 6 and 10 appears to lack proper antecedent basis.

iii. the limitation “the playback information item” recited in Claim 10 at lines 13-14 appears to lack proper antecedent basis;

this limitation should be changed to – the coded playback information item – in order to have proper antecedent basis.

iv. the limitation “the inquiry information item” recited in Claim 11 at line 2 appears to lack proper antecedent basis; this limitation should be changed to – the playback authorization inquiry information item – in order to have proper antecedent basis.

b. Vague and Indefinite

The limitation “the playback device” recited in claim 2 (line 3) appears to be vague and indefinite because it is unclear as to which playback device (e.g., the playback device recited at line 10 of claim 1 or the playback devices recited at line 19; and if the playback devices at line 19 are being referred to, which one these playback devices?). The same deficiency is also noted in claim 11 (line 12).

Claim Rejections – 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by the admitted prior art (APA) of pages 1-2 of Applicant's background. Applicant has admitted therein that document WO99/03277 published in

January 21, 1999 discloses a pay-per-view system which comprises an authorization device, a set top box (e.g., communication device) and a playback device and which appears to perform the bonus determining method claimed in this instant application. Hereinafter, the Office action relies on features described at p. 1, line 6 to p. 2, line 2 of Applicant's Specification and also on those described in the disclosure of the aforementioned document for the rejection of the claims. The 102 rejection is not to be construed to be a rejection over multiple references since the description at p.1, line 10 to p. 2, line 2 is interpreted to be a summary of the features and functions of the pay-per-view system described in WO99/03277.

Claim 1

APA discloses at least:

recording a coded playback information item (p.1, line 9, e.g., "a chargeable film is stored as coded playback information"), and recording a link information item which identifies an authorizing device authorized to grant a playback authorization for the coded playback information item (p. 1, lines 12-15), and recording at least one recorder identification information item on a recording carrier with the aid of the recording device, the recorder identification information item identifying the recording device (p. 1, lines 19-21, e.g., "[i]f the user of the DVD unit has a valid account with the authorization device... the playback authorization for the chargeable film is then obtained..."; it is noted that in order to verify that the account is valid, the DVD unit has to send a recorder identification number stored thereon for the authorizing device to check the validity of this id number);

obtaining a playback authorization for the coded playback information item, played back with the aid of a playback device from the recording carrier or from a copy of the recording carrier, from the authorizing device identified by the played back link information item, in order to permit a pay per view billing of a playback charge (p. 1, lines 16-25);

transferring the at least one recorder identification information item, played back from the recording carrier or from the copy of the recording carrier, to the authorizing device identified by the played back link information item (p. 1, lines 16-25); and

determining the bonus information item for the user of the recording device from the number of recorder identification information items transferred during a billing period from playback devices to the authorizing device and identifying the recording device (p.1, line 26 to p. 2, line 2).

Claim 5

APA discloses at least *a playback device (e.g., "DVD unit") for obtaining a playback authorization for playing back (p. 1, lines, 18-19) a coded playback information (p. 1, line 9) recorded on a recording carrier (e.g., "DVD disk") having*

playback means (e.g., "DVD unit) for playing back the coded playback information item and for playing back a link information item which identifies an authorizing device authorized to grant the playback authorization for the coded playback information item, and for playing back at least one recorder identification information item from the recording carrier, the recorder identification information item identifying a recording device with the aid of which the coded playback information item was recorded on the recording carrier (p. 1, line 6 to p. 2, line 2), and having

communication means (e.g., "set top box") for establishing a communication link, identified by the link information item, played back from the recording carrier, with the authorizing device, in order to obtain the playback authorization for the playback information item played back from the recording carrier, the communication means being designed for transferring the at least one recorder identification information item, played back from the recording carrier, to the authorizing device (p. 1, line 6 to p. 2, line 2).

Claim 10

APA discloses, at least at p. 1, line 6 to p. 2, line 2, *an authorizing device (p. 1, line 7) for granting a playback authorization for playing back a coded playback information item with the aid of a playback device, and for determining a bonus information item (p.1, line 26 to p. 2, line 2) for a user of a recording device, having*

communication means (e.g., "set top box") for receiving a playback authorization inquiry information item (p. 1, lines 16-25; as discussed in the rejection of claim 1, this feature is deemed inherent to the process of checking the validity of the account described at p. 1, lines 19-21), which identifies the playback device and a coded playback information item provided by the playback device for playing back from the recording carrier, and which includes a recorder identification information item, the recorder identification information item identifying the recording device with the aid of which the coded playback information item provided for playing back was recorded on the recording carrier, and having

authorizing means for checking whether a successful pay per view billing of a playback charge is warranted for the user of the playback device and, in the event of a positive checking result, for billing the playback charge for playing back the playback information item, and for outputting a grant of playback authorization information item to the playback device, and having bonus information determining means for determining the bonus information item for

the user of the recording device from the number of recorder identification information items transferred during a billing period from playback devices to the authorizing device and identifying the recording device (p.1, line 10 to p.2, line 2).

Claims 2, 6 and 11

APA further discloses a recorder identification information item transferred to the authorizing device from the playback device when the playback authorization is obtained is only rated for determining the bonus information item for the user of the recording device when the authorizing device has actually also granted the playback authorization for this playback device (p.1, line 16 to p. 2, line 2).

Claims 3, 7 and 13

APA further discloses the link information item represents an Internet address of the authorizing device, and in which both the obtaining of the playback authorization from the authorizing device, and the transferring of the recorder identification information item to the authorizing device are performed via data lines of the Internet (p.1, lines 13-15).

Claims 4 and 12

APA further discloses the authorizing device stores user data for billing the playback charge to the user together with at least one recorder identification information item which identifies a recording device and/or playback device of the user (p. 1, line 26 to p. 2, line 2; it is noted that in order to allow specific users of the system a quantity rebate, user data for billing has to be stored on the database of the authorizing device).

Claim 8

APA further discloses *the playback means are designed for playing back all those recorder identification information items recorded on the recording carrier, which identify all those recording devices which have contributed to creating the copy of the recording carrier played back by the playback device, and in which the communication means are designed for transferring all the recorder identification information items, played back from the recording carrier, to the authorizing device* (WO99/03277, FIG. 1, items 2, e.g., DVHS video recorder and 3, e.g., DVD recorder; each has its own identification information).

Claim 9

APA further discloses *recording means are provided which are designed for recording on the recording carrier the coded playback information item, the link information item and the recorder identification information item identifying the playback device* (WO99/03277, FIG. 1, items 2, e.g., DVHS video recorder and 3, e.g., DVD recorder; each has its own identification information).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:15 am to 5:35 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Anthony Nguyen-Ba", with a long horizontal flourish extending to the right.

ANTONY NGUYEN-BA
PRIMARY EXAMINER

December 19, 2006